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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,688	03/01/2004	Jeffrey Bergh	129843.1082 (H.072A)	2600
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GARDERE / JHTL GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER KENNEDY, JOSHUA T	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 11/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,688	Applicant(s) BERGH ET AL.	
	Examiner JOSHUA T. KENNEDY	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-89,92 and 93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-89,92 and 93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2009 has been entered.

Claims 1-78, 90 and 91 have been cancelled.

Claims 79-89, 92 and 93 have been examined.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 79-89, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al and Newberry.

As to Claim 79, Caceres et al disclose a fencing system comprising:

an elongated member (13) having at least a front surface and a back surface (20); and

a uniform repeating pattern provided on each of the front surface and the back surface of the elongated member (Col 3, Lines 32-33) wherein the pattern is consistent and is capable of being repeated on each of the front surface and the back surface of the elongated member (Examiner considers the pattern to be “capable of” being repeated. For example, a flat or horizontally ribbed surface/pattern/texture is easily repeated on the front and back surfaces).

However, Caceres et al do not disclose the elongate members comprising fiber cement having fibers, wherein the fiber cement forming the elongated member incorporates a low-density additive such as micro spheres or volcanic ash as well as moisture resistant cellulose fibers

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has “applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking” (Par. 107, Lines 1-5). Examiner notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the plurality of individual members of Caceres to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with “workability at an economical price, as well as

improved dimensional stability” (Par. 10) such as a lowered density of the material, yielding expected and predictable results.

Further, Caceres et al do not disclose the pattern of embossed fiber cement fibers being provided using a plurality of rollers, wherein each roller has a textured surface and is adapted to turn at a predetermined speed relative to the elongated member to achieve a high fidelity transfer of the pattern to the front surface and the back surface of the elongated member wherein the pattern is formed of the same material as the elongated member. Examiner notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation “the pattern being provided using a plurality of rollers, wherein each roller has a textured surface and is adapted to turn at a predetermined speed relative to the elongated member to achieve a high fidelity transfer of the pattern to the front surface and the back surface of the elongated member wherein the pattern is formed of the same material as the elongated member” has been given only limited patentable weight and does not serve to structurally distinguish the claims. See MPEP § 2113. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Assuming, arguendo, that the pattern of Caceres would not be consistent/uniform nor repeatable, Newberry Jr. teaches a similar fencing system having each component

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formed using the same material in a mold impression of a fence component such that each fence component made by the mold would have a uniform, repeating pattern. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify elongated members of Caceras et al in view of Gleeson et al to have the exterior pattern being formed of the same material as the elongated member and using a mold impression as taught by Newberry Jr. to more easily, uniformly and repeatably reproduce the surface of the panel desired (Col 4, Lines 37-44) without the requirement of an additional process step or additional materials, yielding expected and predictable results. It is also noted that it has been consistently held that change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

As to Claim 80, it is noted that the limitation of “wherein the elongated member is cut to size and shaped for use in the fence system prior to curing the fiber cement, wherein the elongated member does not exhibit any substantial fraying of the fibers along the surfaces of the elongated member after curing” imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed or how the members are sized and shaped when all features and structure are present. See MPEP § 2113. The claimed structure matter appears to be met by the rejection, above, and therefore it has been held that if the product defined in

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the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See *In re Thorpe*, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

As to Claim 81, Caceres et al disclose a fencing system wherein the elongated member has at least one surface that has a pre-finish thereon (Col 3, Lines 32-33).

As to Claim 82, Caceres et al disclose a fencing system wherein the elongated member resembles a picket (Fig 1).

As to Claim 83, Caceres et al disclose a fencing system wherein the elongated member has an upper end, wherein the upper end is formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1).

As to Claim 84, Caceres et al disclose a fencing system wherein the front surface and back surface of the elongated member has a finish that resembles wood (Col 3, Lines 34-35).

As to Claim 85, Caceres et al disclose the fencing system significantly as claimed, but do not explicitly disclose the front surface and back surface of the elongated member has a finish that resembles masonry.

Newberry Jr. teaches a similar fencing system having “the general appearance of stone...fences” (Col 1, Lines 46-47). Newberry Jr. does not disclose any structural or functional significance as to the aesthetic appearance of the fence and Examiner notes that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Accordingly .it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fencing system of Caceras et al to have the appearance of masonry, as taught by Newberry, Jr. as the reference does not disclose any structural or functional significance as to the exterior appearance of the fence as this is merely an aesthetic design choice yielding expected and predictable results.

As to Claims 92 and 93, Caceras et al disclose a fencing system comprising:

- an elongated member (13) having at least a front surface and a back surface;
- and

- a uniform repeating pattern of provided on each of the front surface and the back surface of the elongated member, wherein the front surface and back surface each having a pattern do not exhibit surface inconsistencies as compared to fencing systems not made of fiber cement..

However, Caceras et al do not disclose the elongate members comprising fiber cement having fibers

Gleeson et al teach a fiber cement building material having cellulose fibers that has “applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking” (Par. 107, Lines 1-5). Examiner notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the plurality of individual members of Caceras to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it’s a lightweight material with “workability at an economical price, as well as improved dimensional stability” (Par. 10) such as a lowered density of the material, yielding expected and predictable results.

Further, Caceras et al do not disclose wherein the pattern is uniformly and repeatably formed of the same material as the elongated member.

Newberry Jr. teaches a similar fencing system having each component formed using the same material in a mold impression of a fence component such that each fence component made by the mold would have a uniform, repeating pattern. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify elongated members of Caceras et al in view of Gleeson et al to have the exterior pattern being formed of the same material as the elongated member and using a mold impression as taught by Newberry Jr. to more easily, uniformly and repeatably reproduce the surface of the panel desired (Col 4, Lines 37-44) without the requirement

of an additional process step or additional materials, yielding expected and predictable results. It is also noted that it has been consistently held that change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Response to Arguments

Applicant's arguments filed 10/9/2009 have been fully considered but they are not persuasive.

Applicants argue:

“As the Examiner acknowledges in the Office Action, the components of Caceras are not repeatable and the mold product of Newbery contains blemishes and irregularities as a result of the quality of the raw material that forms the mold. “

Examiner respectfully disagrees and notes that this statement is incorrect. It was never acknowledged that the components of Caceras are not repeatable. In fact, in both the rejection and the response to arguments, it was noted that the Examiner considers the pattern to be “capable of” being repeated. For example, a flat surface/pattern/texture is easily repeated on the front and back surfaces. Further, there was no acknowledgement of anything regarding blemishes and irregularities in the mold product of Newberry.

Applicants further argue:

“Applicants further submit that the disclosure of a molded fence (as in Newberry), a fiberglass fence (as in Caceras), and the general references made in Gleeson,

would not lead a person of ordinary skill in the art to combine these references, nor is there any motivation in these references for the combination, to arrive at Applicants' novel fencing system. Further, there is no disclosure or suggestion in the references of how the respective different components would, or even could, satisfy the limitations of Applicants' pending claims which positively recite, among other things, a fencing system containing a uniform repeating pattern of embossed fiber cement fibers provided on each of the front surface and the back surface of the elongated member (for example as recited in claim 79 and 92) which do not exhibit surface inconsistencies as compared to fencing systems not made of fiber cement (for example as recited in claim 93)." (Pages 5-6)

Examiner respectfully disagrees. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, the combination of Caceres, Newberry and Gleeson teach a fence made up of individual slat members (Caceras), made using a fiber cement material (Gleeson) and having a repeated pattern via a mold (Newberry).

Examiner further notes that it has been held that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art.

See In re Keller, 642 F.2d 413, 425, 08 USPQ 871, 881 (CCPA 1981).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Joshua T. Kennedy/
Examiner, Art Unit 3679
10/27/2009

/Daniel P. Stodola/
Supervisory Patent Examiner, Art Unit 3679